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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,325	12/08/2003	Jerome Skuba	Skuba-P1-03	2418

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PETER K. TRZYNA, ESQ.  
P O BOX 7131  
CHICAGO, IL 60680

EXAMINER
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PALO, FRANCIS T

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/730,325

**Applicant(s)**

SKUBA, JEROME

**Examiner**

Francis T. Palo

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

The objections made in the prior office action mailed 1/11/05 regarding the specification and claims are withdrawn in consideration of the amendments filed 3/11/05.

The defective rejection of claims 1-15 in the prior office action is acknowledged and remedied in this second non-final office action.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 6-15** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding **claims 6-13**:

The claims cite mats differing by one through eight members of the group cited in claim-3; It is unclear to the Examiner what is meant by the limitations whereby, mats differ by at least one or more members of the group cited in claim-3 when,

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in addition to the vascular members cited, spaces for the vascular members as well as walkway and garden accouterment are cited. Specifically, how do mats differ by space for the vascular examples cited, or space for a walkway or space for accouterment?

Is the Applicant intending to cite mats consisting of forbs, shrub, tree, annuals, flowering plants, bush, wildflowers, grass and crop; if so, Milstein teaches fifteen wildflower species in Table-A and it has already been discussed Milstein teaching domesticated perennial and annual plants as mat material.

Regarding repeating **claims 14 and 15**:

As with the instant claims discussed above, the written description does not adequately describe the claim limitation, "lawn on a portion of at least one of the mats", as cited.

Grass mats or sod is notoriously well known however in the art of plant husbandry.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-15** are rejected under 35 U.S.C. 103(a),  
as being unpatentable over Milstein (US 4,941,282),  
in view of Mykrantz (US 5,246,253) and Otwell (US 1,846,274).

Regarding **independent claim-2**:

The instant claim is afforded priority in examination because it is broader than and encompasses instant independent claim-1.

**Milstein** '282 is relied upon for the teaching of growing mats of different kinds of plants as cited.

Specifically, Milstein teaches providing the consumer with an established sod mat (Abstract), and the manufacture, propagation, storage and transportation of wildflower mats in a controlled environment, and concludes the teachings with, "It should be noted that while the present invention is suitable for the propagation of wildflowers, the propagation technique disclosed herein is equally applicable to domesticated perennial and annual plants.", (column-4, beginning at line-3).

The cited steps of implementing and installing a garden, are well known and inherent to the art of landscaping, and are disclosed in the background of numerous patents (Milstein discloses in the Background of the Invention; "Sod mats and rolls have long been used in the seed and plant industry as a convenient device for the transport, storage and installation of seeds and seedlings.");  
in the alternative, Mykrantz '253 and Otwell '274 serve to provide those cited steps.

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**Mykrantz** discloses as prior art, "It is desirable when planting a garden (e.g., a flower garden), to plan its appearance prior to engaging in the labor and expense of planting the garden.", (column-1, beginning with the second sentence).

**Otwell** teaches a mulching paper of varying sizes and forms (read as; forming a design, as cited), adapted either for seed beds, a continuous line of planting along fence walls, foundation walls with openings for shrubs, tall and low growing perennials, plants living from year to year, plants living for one or two seasons.....the whole being designed to produce a continuous harmonious effect in color, size and ground line.", (page-1, line-91 through page-2, line-3).

In conclusion, the Examiner contends that the instant invention as cited in the independent claims is obvious over the teachings of Milstein in view of Mykrantz and Otwell, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have utilized the invention of Milstein in the garden planning of Mykrantz and pattern of Otwell, for the well-known advantages of that combination.

Regarding **independent claim-1** and **dependent claim-3**:

The discussion above regarding claim-2 is relied upon.

As discussed above, Milstein teaches forming a piece corresponding to at least one of the members cited in the instant claim.

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Regarding **claims 4 and 5**:

Milstein in view of the pattern of Otwell teaches a second and third member as cited, as Otwell depicts at least three members in the planting pattern.

Regarding **claims 6-13**:

In consideration of the 35 U.S.C. 112 rejections made above, Milstein teaches in Table-A, fifteen species of wildflowers ("some species") as mat material and further teaches domesticated perennial and annual plants.

Regarding repeating **claims 14-15**:

In consideration of the 35 U.S.C. 112 rejections made above, Milstein teaches domesticated perennial and annual plants, of which grasses (as cited) are readable on.

### ***Double Patenting***

In consideration of the 35 U.S.C. 112 rejections made above, and in anticipation of claim amendments to instant claims 6-15, the Applicant can anticipate a non-statutory obvious type double patenting rejection to be made in the next and final office action, with respect to the Applicant's issued Patents US 6,336,291 and 6,658,790. The Applicant may wish to consider submitting a Terminal Disclaimer for the sake of compressed prosecution in anticipation of the double patenting rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bole, Lewis and Kamm teach landscape planning.

Smith teaches a modular ground cover for custom floricultural grounds displays.

Loads teaches grass sod lamina.

Welch teaches a vegetable growing mat.

Pacific Earth teaches growing many types of ground covers at least as early as 1966.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 571-272-6907. The examiner can normally be reached on M-Tu.,Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 800-786-9199 (toll-free).

A handwritten signature in black ink that reads "Francis T. Palo". The signature is written in a cursive, flowing style.

Francis T. Palo  
Examiner  
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